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**REMARKS/ARGUMENTS**

Applicant has herein amended claim 5. Claims 1-14 will still be pending in the application after entry of this amendment. No additional fee is due. Applicant hereby requests reconsideration in view of the foregoing amendments and the remarks made below.

**35 U.S.C. 101 Rejections**

The Examiner has rejected claims 5-8 under 35 U.S.C. § 101 as being non-patentable subject matter. Specifically, the Examiner has indicated that claims 5-8 are directed to a "computer program product" and that this is the equivalent of software. Applicant disagrees.

The "computer program product" of claim 5 is not the equivalent of merely "software" as alleged by the Examiner. See Final Office Action Page 2. Claim 5, as amended herein, recites: "[a] computer program product comprising a computer-readable medium having computer program code embodied therein". Thus, the "computer program product" of claim 5 comprises a "computer-readable medium". If the "computer program product" of claim 5 is equivalent to merely software, then that would mean that software would "[comprise] a computer-readable medium." This is not possible. Instead the "computer program product" of claim 5 comprises a "computer-readable medium" that is tangible and machine-readable.

As a result of the Federal Circuit decision of *In re Beauregard*, 53 F.3d 1583, 35 U.S.P.Q.2d 1383 (Fed. Cir. 1995), a claim reciting a "computer program product" is proper patentable subject matter. In fact, the exact wording in the claim of U.S. Patent Number 5,710,578 (Beauregard et al.) that the Federal Circuit allowed was "[a] computer program product comprising: a computer usable medium having computer readable program code means embodied in said medium . . . ." Furthermore, since this decision, the USPTO has properly allowed the use of "computer program product" embodied in a tangible medium – patentable subject matter under 35 U.S.C. 101. Because the "computer program product" is embodied in a machine-readable medium, this claim is proper under 35 U.S.C. 101.

Applicant respectfully requests the Examiner reconsider and withdraw this rejection.

**35 U.S.C. § 112 Rejections**

The Examiner has rejected claims 1, 2, 5, 6, 9-11, 13, and 14 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter of

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the invention. The Examiner bases this rejection on the use of the term "object" in these claims, saying that it is unclear what an object is. Applicant strongly disagrees.

Firstly, the Examiner is taking the term "object" out of context. The full terms that are at issue are "dynamic protocol object" and "static protocol object." Applicant re-iterates that these terms are standard terms that are well-known in the computer programming arts, and thus should be given its ordinary meaning in the art. See MPEP 2111.01 (stating "the words of the claims must be given their plain meaning unless applicant has provided a clear definition in the specification"). See also *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 225 U.S.P.Q. (BNA) 634 (Fed. Cir. 1985) (stating if the claims "reasonably apprised those skill in the art of the utilization and scope of the invention, and if the language is as precise as the subject matter permits," then the claims are proper).

Secondly, when reading applicant's specification, one skilled in the art would easily understand the meaning of "dynamic protocol object" and "static protocol object". See MPEP 2173.05(a) (stating "if the claims, read in light of the specification, reasonably apprise those skilled in the art," a 112 paragraph two rejection is improper). For example, the following excerpt from Applicant's application (pages 2-3, original application) (emphasis added) clearly shows what is referred to when discussing "dynamic protocol object":

[0006] The dramatic increase in Internet usage and in other forms of client/server communication in recent years has meant that servers receive more and more requests and are handling more and more connections and responses. Therefore, the speed at which servers operate in terms of the number of requests handled in a given time period has become very important in the overall speed and performance of Internet and other computer communication systems.

[0007] One factor that adversely affects the performance of an operating system and applications installed on a server is the need for the server to repeatedly assemble and format the same reply repeatedly, using up overhead and instruction cycles each time. One example of such a reply is a Web page. If any part of the page changes for each "hit," the entire page must be reformatted and assembled to be sent to a browser. Such a page is referred to as a dynamic reply. The part of the page that changes is referred to as a dynamic object. Static replies or pages, by contrast, can be cached at the server and sent without having to be reassembled and formatted. But increased use of dynamic content on the Internet has made such static replies few and far between.

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[0008] Often large portions of a Web page stay the same over many accesses by many different client applications or Web browsers. Sometimes only a time and date field or an advertisement changes. Yet the server must reassemble the complete page each time a browser requests it. If the same browser requests the page again, it is possible for the browser to cache static objects that form portions of the page, and only retrieve the dynamic objects.

From the context of these paragraphs in Applicant's specification, it is clear that a "dynamic object" is the "part of the [Web] page that changes" for each "hit." Similarly, in the above excerpt, a "static object" is part of the Webpage that does not change for each "hit." One skilled in the art would understand this after reading Applicant's specification.

Third, it is not proper for the Examiner to simply state "[i]t is unclear what an 'object' is since a plurality of objects exist within the art." As an initial matter, Applicant objects to this vague assertion. In particular, if the term "object" is unclear to the Examiner, the Examiner should specifically identify how the term is unclear giving more than just the above-identified conclusive statement. A broad-brush statement that "a plurality of objects exist within the art" denies the Applicant a full opportunity to address and refute the indefiniteness rejection of Applicant's claims. In other words, without a specific identification of how the terms "static protocol object" and "dynamic protocol object" are unclear, it is not possible to fully respond to the rejection given that the true basis for the rejection is not ascertainable.

Nonetheless, Applicant believes that the meaning of the claim term, "object" with respect to "dynamic protocol object" and "static protocol object" is clear to one skilled in the art, especially after reading Applicant's specification. Thus, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. 112 rejections of claims 1, 2, 5, 6, 9-11, 13, and 14.

#### 35 U.S.C. § 102(e) Rejections

The Examiner has rejected all claims under 35 U.S.C. § 102(e) as anticipated by U.S. Patent 6,256,712 to Challenger et al. ("Challenger"). Applicant disagrees respectfully.

In the Remarks section of the Final Office Action, the Examiner stated "the examiner has interpreted the claimed 'objects' to be equivalent to data." Then, it appears that the Examiner has block copied the same verbiage from the previous Office Action, providing language from the "Summary of the Invention" of Challenger. Such a vague rejection of Applicant's claim limitations is improper. In particular, if Challenger teaches each of the claimed limitations, the

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Examiner should specifically identify where in the Challenger reference each of those individual limitations are disclosed. A broad-brush remark section that does not indicate where each limitation of Applicant's claimed invention can be found in Challenger denies the Applicant a full opportunity to address and refute rejection of Applicant's claims. Without a specific identification of how Challenger anticipates each of those separate limitations, it is not possible to fully respond to the rejection given that the true basis for the rejection is not ascertainable.

In order for a claim to be anticipated, the cited reference must teach every element of the claim, either expressly or inherently. MPEP 2131. All of Applicant's claims, either directly, or through dependency, have recitations that cannot be found in Challenger.

Nowhere does Challenger discuss each of the following claimed limitations: 1) receiving an application protocol request from a client application; 2) having the server respond to this request by sending the dynamic protocol objects to the client application; 3) retrieving a static protocol object from cache in an operating system kernel; and 4) sending this static protocol object to the client application. Rather Challenger discusses "maintaining updated caches and making consistent updates" to these caches. See Challenger, column 2, lines 53-55.

All of Applicant's claims recite a "request" and a server "response that can be displayed as a combination of a dynamic protocol object and a static protocol object." Challenger, by contrast, does not discuss responding to requests. That is because Challenger only "maintains the validity of the page at all times, and automatically [updates] it when the data changes." This is completely different than what Applicant has claimed – a method of only updating in response to the client application requests for updates.

Challenger is not "retrieving the static protocol object from a cache disposed in an operating system kernel" as recited in all of the independent claims. Challenger is only interested in constantly updating data content that has changed and validating WebPages on the server. Challenger does not discuss retrieving the *static* protocol object from cache in an operating system kernel.

Additionally, all of Applicant's claims recite the use of a cache disposed in an operating system kernel. Challenger does not disclose this recitation. The portions of Challenger cited by the Examiner discuss either a proxy cache or a processor cache, neither one of which resides in a

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kernel. A proxy cache resides in user space and a processor cache resides inside the processor hardware. Challenger does not even mention the kernel, let alone an in-kernel cache.

The Examiner stated in the Remarks Section of the Final Office Action that "the use of a cache/buffer/registry within an operating system of a computer is inherent." Applicant respectfully submits that, if the Office Action is alleging that this explicit recitation is inherent in the Challenger method, extrinsic evidence must be produced which establishes that the recitation would have been recognized by persons having ordinary skill in the art in view of the Challenger disclosure. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). No evidence has been presented by the Examiner. Accordingly, the Examiner must support this assertion with evidence or withdraw this rejection.

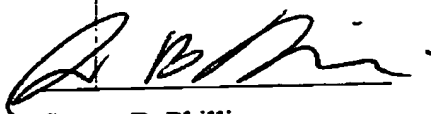
Challenger does not teach each element of the claimed present invention. Thus, a 35 U.S.C. § 102 rejection is improper. Furthermore, when the claimed invention is taken as a whole, Challenger does not anticipate the present invention.

Applicant requests the Examiner reconsider and withdraw all rejections.

Respectfully submitted,

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